

REMARKS

At the outset, applicants submit that the Office Action does not provide the Examiner's rationale for the rejection of independent apparatus claim 28. The Examiner has listed apparatus claim 28 with his discussion of independent method claim 14. However, the limitataions of claim 14 and 28 are distinct, and therefore the Applicants are without a clear understanding of the basis for the rejection of claim 28. Applicants request, upon consideration of the argument presented herein, that the Examiner either allow the application or issue a new **non-final** office action which identifies specific reasons for rejecting claim 28. Otherwise the prosecution of this application will be prejudiced by denying the Applicants an opportunity to substantively respond to the Examiner's unstated positions.

Claims 14 - 31 remain in the application. All of the claims are rejected under Section 102 based on U.S. 7,353,280 (Chiles). Applicant respectfully requests reconsideration and allowance of the claims without amendment in view of the following remarks.

As is well known, to reject the claimed subject matter it is essential to identify every feature recited in the claim with the same specificity as claimed. In the present instance it is submitted that the Chiles reference fails to disclose or suggest the invention of claims 1 and 28 such that the claimed subject matter is both novel and non-obvious over the prior art. Specifically, although the Examiner has referenced text at page 5 of the Office Action (see Chiles at col. 10, lines 31-34 and lines 46-49) there is no disclosure in the reference that relates to the combination comprising the following features of claim 1:

verifying message header entries of data packets exchanged between the external device and the first network element, wherein

if a message header entry characterizing an expanded packet-oriented protocol is detected, a temporarily transparent connection is established between the first network element and the external device, and wherein

the unique address of the first network element is transferred to the external device without being converted by the network node device.

The rejection of claim 1 does little more than cite Chiles at col. 10, lines 31-34 and lines 46-49, and does not seem to recognize the conjunctive aspects of the claim (i.e., "and wherein") which preclude a piecemeal reconstruction of elements taken from different embodiments (e.g.,

figures 7 and 8). Nor does the cited passage recognize that the method is applied in the context of a packet-oriented network of the type having "*the unique address of a network element converted into an address valid for the external device by the network node device ...*" The invention is an improvement over prior art networks of this type.

Specifically, the cited passage has no disclosure relating to "**verifying message header entries of data packets exchanged between the external device and the first network element**" and does **not** relate to establishing a connection

"if a message header entry characterizing an expanded packet-oriented protocol is detected ..."

Applicants submit that the Chiles reference discloses no more than that which has already been acknowledged in the patent specification as prior art. More is required because claim 1 as presented is not the same as that which Chiles discloses.

The rejection of claim 28, directed to a network node element, is distinct over Chiles because it requires, among other features,

at least one monitoring unit for monitoring message header entries of the data packets exchanged between the external device and a first network element, wherein the monitoring unit is configured to detect a message header entry characterizing an expanded packet-oriented protocol and to establish a temporarily transparent connection between the first network element and the external device, and whereby no address conversion of an address allocated to the first network element by the external device for the duration of the transparent connection is performed.

As already urged, the rejection of apparatus claim 28 is without support and there does not appear to be basis for rejecting the claim. Allowance is requested. If the Examiner believes allowance is not in order, the Examiner is requested to issue a non-final office action permitting the applicants to amend the claims in view of the Examiner's so far unstated positions.

Conclusion

The claims are allowable for the reasons presented. If the Examiner disagrees it is incumbent upon the Examiner to issue a non-final office action which provides detailed support

for the rejection of claim 1 instead of mere citation to marginally relevant passages. Further, if the Examiner does not agree that claim 28 is allowable, the Examiner is obliged to present argument in an non-final office action as to how the Chiles reference can be applied to claim 28.

The Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, including the fees specified in 37 C.F.R. §§ 1.16 (c), 1.17(a)(1) and 1.20(d), or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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